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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/731,941	12/06/2000	James M. Allen	226272001403	6840

7590 02/17/2004

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EXAMINER

WHITEMAN, BRIAN A

ART UNIT	PAPER NUMBER
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1635

DATE MAILED: 02/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/731,941	ALLEN, JAMES M.	
	Examiner	Art Unit	
	Brian Whiteman	1635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/13/03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-7,9-12,14-17,21,22,24-34 and 38-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,2,6,10-12,14,15,21,22,25,30 and 32 is/are allowed.
- 6) ☒ Claim(s) 3,5,7,9,26,27,28,29, and 31 is/are rejected.
- 7) ☒ Claim(s) 16,17,24,33,34 and 38-41 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/13/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Non-Final Rejection

Claims 1-3, 5-7, 9-12, 14-17, 21, 22, 24-34, and 38-41 are pending examination.

Applicant's traversal, the cancellation of claims 35-37 and the amendment to claims 1, 10, 16, 17, 24, 25, 33, 34, and 38 filed on 11/13/03 is acknowledged and considered.

Information Disclosure Statement

The US applications cited on the IDS filed on 11/13/03 were considered by the examiner, but were not initialed on the PTO-1449 because the US applications are not considered published documents.

Priority

This application filed under former 37 CFR 1.60 lacks the necessary reference to the prior application. A statement reading, "This is a CON of Application No. 08/564,167, filed 12/14/95." follows the title of the invention or as the first sentence of the specification. However, the current status of the nonprovisional parent application (ABN) referenced is not included.

Claim Objections

Claims 16, 17, 33, and 34 are objected to because of the following informalities: the phrase is "an AAV packaging cell" is a grammatically improper phrase for a dependent claim.

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Suggest amending the phrase to recite -- the AAV packaging cell --. Claims 39 and 40 are objected to because they depend on claims 33 and 34, respectively.

Appropriate correction is required.

Applicant is advised that should claim 16 be found allowable, claims 17, 24, 33, 34, and 38 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). Claims 39, 40, and 41 are objected because the claims depend from claim 33, 34, and claim 38, respectively.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 3, 5, 7, 9, 26, 27, 28, 29, and 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 3 and 27 recite the limitation "said packaging cell" on line 2. There is insufficient antecedent basis for this limitation in the claims. Suggest replacing the term "said packaging cell" with the term -- said mammalian cell --.

Claims 5, 7, 9 are indefinite because the claims depend on claim 3. Claims 28 and 29 are indefinite because the claims depend on claim 27.

Claim 26 recites the limitation "said helper virus" on line 1. There is insufficient antecedent basis for this limitation in the claim. Claims 28 and 31 are indefinite because they depend on claim 26.

Response to Arguments

Applicant's arguments, filed 11/13/03, with respect to specification objection have been fully considered and are persuasive. The objection to the specification has been withdrawn because of the amendment to the specification. See pages 13 and 14.

Applicant's arguments, filed 11/13/03, with respect to 112 first paragraph written description have been fully considered and are persuasive. The rejection of claims 1-3, 5-7, 9-12, 14-17, 21, 22, 24-34, and 38-41 has been withdrawn because of the amendment to the independent claims. See pages 15-16.

Applicant's arguments, filed 11/13/03, with respect to double patenting over US 6,541,258 have been fully considered and are persuasive. The rejection of claims 1, 2, 6, 10, 11, 12, 15-17, 21, 22, 24-26, 30, 32, 34, and 40 has been withdrawn because of the amendment to the independent claims. See pages 15-16.

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Conclusion

Claims 1, 2, 6, 10-12, 14, 15, 21, 22, 25, 30, and 32 are in condition for allowance because the claims are free of the prior art of record.

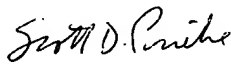
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Whiteman whose telephone number is (571) 272-0764. The examiner can normally be reached on Monday through Friday from 7:00 to 4:00 (Eastern Standard Time), with alternating Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John LeGuyader, SPE - Art Unit 1635, can be reached at (571) 272-0760.

Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center number is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Brian Whiteman
Patent Examiner, Group 1635


SCOTT D. PRIEBE, PH.D
PRIMARY EXAMINER